

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant	:	Hong Q. Bui
Appl. No.	:	09/457,839
Filed	:	December 9, 1999
For	:	SYSTEM AND METHODS FOR FACILITATING TRANSACTIONS ON, AND PERSONALIZING WEB PAGES OF, THIRD PARTY WEB SITES
Examiner	:	Cristina Sherr
Group Art Unit	:	3621

THIRD REPLY BRIEF

United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

This Third Reply Brief is responsive to the Examiner's Answer issued on June 26, 2007 (the "Third Examiner's Answer"). The Third Examiner's Answer raises a new ground for rejection under 35 U.S.C. § 101 with respect to claims 41, 42, 44 and 45, and re-asserts the art-based rejections that were included in first and second Examiner's Answers issued on April 10, 2007, and June 26, 2007, respectively. Appellant's reply to the new ground for rejection begins at page 13.

This Third Reply Brief supersedes Appellant's first and second Reply Briefs. The arguments presented in this Thirst Reply Brief supplement those made in Appellant's Amended Second Appeal Brief filed on October 23, 2006 (the "Second Appeal Brief").

1. Rejection of claims 36-39, 41, 42 and 66 under 35 U.S.C. § 103(a) over Foster

Claims 36-39, 41, 42 and 66 stand rejected on obviousness grounds over Foster (U.S. Patent 6,332,134, which claims priority to provisional application no. 60/162,651). As in the Third Examiner's Answer, references to "Foster" in the following discussion refer to the provisional application.

Independent claim 36

In the Second Appeal Brief, Appellant argued that Foster does not teach or suggest the following features of claim 36 in the context of the other recitations of the claim: "wherein the server system maintains a log of purchases made by the registered user from each of a plurality of merchant web sites, uses the log to generate an interests profile for the registered user, and disseminates the interests profile to the merchant web sites to allow the merchant web sites to provide personalized content to the registered user."

In connection with the claim language "the server system maintains a log of purchases made...from each of a plurality of merchants," the Third Examiner's Answer points to Foster's disclosure of a CardFort database that maintains a history of the consumer's CardFort purchases on the consumer's computer. Third Examiner's Answer at pages 6 and 7, under heading "First Issue," citing page 6, lines 5-7 of Foster. As explained in the Second Appeal Brief, however, nothing in Foster suggests that the consumer's computer acts as a server system as defined in the claim. In addition, nothing in Foster suggests moving the task of maintaining the log of purchases to such a server system. Thus, the cited portion of Foster does not teach or render obvious a "server system [that] maintains a log of purchases made...from each of a plurality of merchants" in the context of claim 36.

Regarding the claim language "uses the log to generate an interests profile for the registered user, and disseminates the interests profile to the merchant web sites to allow the merchant web sites to provide personalized content to the registered user," the Third Examiner's Answer points to the following excerpt of Foster:

Because the transaction is tied to the CardFort ID number, the card company can enroll any cardholder in specific affinity or rewards programs. Processing savings and fraud reduction will allow more scope for rewards.

Third Examiner's Answer at page 7, lines 3-6, citing page 7, lines 25-28 of Foster. The cited excerpt, however, says nothing to suggest that the CardFort system either (1) uses a log of the cardholder's purchases to generate an interests profile for the cardholder, or (2) disseminates an interests profile for the cardholder to merchant web sites. In this regard, Foster says nothing to suggest that the affinity or reward programs are even operated by the merchants. In addition, even assuming, *arguendo*, that such a program were operated by one of the merchants, it is not clear why the task of enrolling a cardholder in this program would involve sending an interests profile for the cardholder to the merchant's web site. The Third Examiner's Answer does not address these issues.

The Third Examiner's Answer also points to Foster's statement that the CardFort database "serves as the launch pad for data to the card company." Third Examiner's Answer at page 7, lines 7-9, citing page 6, lines 17-18 of Foster. This statement apparently refers to the process by which product order information is initially stored on the consumer's computer (in the CardFort database), and is then transmitted to the card company's system. See Foster at page 3, lines 24-32. It is not clear how the Third Examiner's Answer is relying on this statement to support the rejection. Indeed, the statement does not teach or suggest the limitations at issue.

For at least the foregoing reasons, Foster does not teach or render obvious all of the limitations of claim 36.

Appellant acknowledges that each and every element of the claim need not be identically found in the cited art. See *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742; 82 USPQ2d 1385, 1397 (2007) (noting that "a person of ordinary skill is also a person of ordinary creativity, not an automaton"). In the present case, however, the Third Examiner's Answer does not identify any particular *reason* that would have prompted one of ordinary skill and creativity to modify Foster to arrive at the claimed invention. See *KSR* at 1731 (noting that "it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does.")

For the foregoing reasons, the Examiner has not established a *prima facie* case of obviousness with respect to claim 36. The rejections of claims 36-39 are therefore improper and should be reversed.

Independent claim 41

In the Second Appeal Brief, Appellant argued that Foster does not teach or suggest the following feature of claim 41 in the context of the other recitations of the claim: "wherein the customer information of the registered user transmitted to the merchant web site system further includes an interests profile that reflects purchases made by the registered user from each of a plurality of online merchants, such that the merchant web site system may personalize web site content for the registered user."

In response, the Third Examiner's Answer points to the same portions of Foster discussed above. Third Examiner's Answer at pages 6 and 7, under the heading "second issue" (note that the analysis of claim 41 is substantially identical to the analysis of claim 36). As discussed above in connection with claim 36, the cited portions of Foster do not teach or suggest the transmission of a user's interests profile to a merchant web site, let alone an interests profile that reflects purchases made by the user from each of a plurality of merchants. Foster simply does not teach or suggest this feature.

For these reasons, the Examiner has not established a prima facie case of obviousness with respect to claim 41. The rejections of claims 41, 42 and 66 are therefore improper.

2. Rejection of claims 44, 45 and 67-69 over Boesch in view of Linehan

Claims 44, 45 and 67-69 stand rejected on obviousness grounds over Boesch (U.S. Patent No. 6,092,053) in view of Linehan (U.S. Patent No. 6,327,578). Claims 44 and 67 are independent.

Independent claim 44

In the Second Appeal Brief, Appellant argued that the rejection of independent claim 44 is improper because, among other reasons, Boesch and Linehan do not individually or collectively teach or suggest the following limitations of the claim:

generating an interests profile that reflects said purchases made by the first user from the plurality of online merchants; and
transmitting the interests profile of the first user to a web site system of at least one online merchant to allow the online merchant to provide personalized web site content to the first user.

In response, the Third Examiner's Answer points to five different passages of Boesch. Third Examiner's Answer at pages 8 and 9, beginning under the heading "Third Issue." Each of these passages is reproduced and discussed below.

Abstract of Boesch: *"The system has a consumer data structure that stores purchasing information for registered consumers. The software is able to access the consumer data structure and enter the consumer's purchasing information during subsequent purchases."* The term "purchasing information" in this passage refers to consumer-supplied information that is used to complete purchase transactions. See Boesch at, e.g., column 5, line 30 to col. 6, line 19. Nothing in Boesch suggests that this "purchasing information" includes an interests profile that reflects purchases made from a plurality of online merchants as claimed. Indeed, the only examples of purchasing information given in Boesch are customer's name, billing address, shipping address, and credit card number. See Boesch at column 6, lines 3-7. Thus, the cited passage does not suggest either the generation of an interests profile that reflects purchases made from a plurality of online merchants, or the transmission of such an interests profile to a web site system of an online merchant.

Column 2, lines 52-54 of Boesch: *"A further object of the present invention is to allow consumer information to be provided to merchants using payment systems from various service providers."* This passage, as best understood by Appellant, refers to the ability of Boesch's Consumer Information System (CIS) to interoperate with the payment systems of a variety of different vendors or service providers, such that the merchants need not use any particular payment system. Again, nothing in this passage suggests either the generation of an interests profile that reflects purchases made from a plurality of online merchants, or the transmission of such an interests profile to a web site system of an online merchant.

Column 2, lines 55-61 of Boesch: *"A further object of the present invention is to use the architecture of the consumer information server to aid the consumer in distributing all manner of information, not just purchase/money information, to a variety of recipients when those recipients are to receive essentially the same information from one recipient to the next."* Nothing in Boesch suggests that "all manner of information," as used in this passage, includes an interests profile that reflects purchases made from a plurality of online merchants. In addition, the Third Examiner's Answer does not explain how or why this passage would have prompted

one skilled in the art to modify Boesch's system to arrive at the claimed feature. Thus, this passage does not support the Examiner's conclusion that Boesch and Linchan collectively suggest the above-quoted limitations of claim 44.

Column 2, lines 62-65 of Boesch: *"A further object of the present invention is to provide a mechanism for direct marketing to consumer wallet holders immediately before, during, or after completion of a transaction using a wallet."* Nothing in Boesch suggests that this "mechanism for direct marketing" includes either the generation of an interests profile that reflects purchases made from a plurality of online merchants, or the transmission of such an interests profile to a web site system of an online merchant.

Column 4, lines 44-49 of Boesch: *"The CIS software can also associate a consumer with an identification code that can be presented to the merchant's computer, thus allowing the merchant to 'recognize' a consumer and provide customer-specific messages, displays, and offers."* Nothing in Boesch suggests that the "customer-specific messages, displays and offers" mentioned in this passage are or can be generated by the merchant's computer using an interests profile that reflects purchases made by the user from a plurality of online merchants. Thus, this passage does not suggest either the generation of such an interests profile, or the transmission of such an interests profile to the merchant's system.

In view of the foregoing, the five passages cited in the Third Examiner's Answer do not teach or suggest the above-quoted limitations of claim 44.

Linchan does not overcome the foregoing deficiencies in Boesch, and the Third Examiner's Answer does not contend otherwise. In addition, the Third Examiner's Answer does not identify a reason that would have prompted one of ordinary skill and creativity to modify the combined system of Boesch and Linchan to arrive at the invention of claim 44.

For at least the foregoing reasons and the reasons explained in the Second Appeal Brief, the Office has not established a prima facie case of obviousness with respect to claim 44. The rejections of claims 44 and 45 are therefore improper.

Dependent claim 45

Claim 45 depends from claim 44, and adds the following: "wherein the interests profile is transmitted to the web site system in response to use by the first user of the electronic wallet service to make a purchase from the web site system." In connection with this claim language,

the Third Examiner's Answer points to the following passage of Boesch: "*The CIS software can tailor its communication with the consumer's computer in accordance with a profile created by the CIS software. The profile is based upon preferences chosen by the consumer or created by the CIS software based on the consumer's behavior, from preferences chosen by the merchant, by a branding party, or the like.*" Third Examiner's Answer at page 9, first full paragraph, citing column 4, lines 47-54 of Boesch.

This passage, however, merely refers to the communications that occur between the consumer/consumer computer and the consumer information server (CIS). It says nothing about the transmission of an interests profile to a web site system of an online merchant. Thus, the cited passage does not support the rejection of claim 45.

Independent claim 67

In the Second Appeal Brief, Appellant argued that Boesch and Linehan do not individually or collectively teach or suggest, in the context of the other limitations of claim 67, the portion of the claim shown below in bold:

67. A method of personalizing a web page of a web site, the method comprising:

sending a cookie to a computer of a user for storage thereon, wherein the cookie corresponds to a domain of a server that has access to at least a name of the user, said domain being different from a domain of the web site so that the cookie is not transmitted to the web site, and wherein the web page includes a reference to an object served by the server, such that when a browser retrieves the web page, the browser is caused to request the object from the server; and

when a browser running on the computer of the user retrieves the web page from the web site and sends a resulting request for the graphic to the server, responding to the request by at least: (a) using the cookie transmitted with the request to identify the name of the user, (b) incorporating the name of the user into an instance of the object, and (c) returning the instance of the object to the user computer for display within the web page.

As a preliminary matter, the term "graphic" in the bolded portion of the claim should be replaced with the term "object" to maintain consistency with the remainder of the claim. (Note

that a graphic is one type of object.) If the claim is otherwise found allowable, Appellant intends to make this change by amendment.

In response to Appellant's argument, the Examiner points to five different passages in Boesch. Third Examiner's Answer at pages 9-11, beginning under the heading "Fourth Issue." Each passage is reproduced and addressed below.

Column 6, lines 61-65 of Boesch: *"In the preferred embodiment, the process starts with a consumer requesting a merchant's offer 200 from a merchant. In response to the consumer's request, the merchant's computer responds by sending a browser readable file and the merchant's offer to the consumer's computer 202. The consumer's browser processes the browser readable file and sends the merchant's offer and a message to the CIS 204."* According to the Third Examiner's Answer, this passage reveals that the merchant's web page causes the user's web browser to send a request for an object to the Consumer Information Server (CIS). Even assuming, *arguendo*, this interpretation is accurate (which Appellant does not concede), nothing in Boesch suggests that the CIS responds to this request by performing the following combination of steps: "(a) using the cookie transmitted with the request to identify the name of the user, (b) incorporating the name of the user into an instance of the object, and (c) returning the instance of the object to the user computer for display within the web page."

Column 7, lines 14-17 of Boesch: *"The message sent from the consumer's browser to the CIS indicates whether the browser contains a browser identifier. In the preferred embodiment, the browser identifier is a cookie."* The Third Examiner's Answer apparently treats this passage as an indication that the browser of the user/consumer sends a cookie to the CIS with a request for an object. Even assuming, *arguendo*, that this reading is accurate (which Appellant does not concede), nothing in Boesch suggests "(a) using the cookie ... to identify the name of the user, (b) incorporating the name of the user into an instance of the object, and (c) returning the instance of the object to the user computer for display within the web page."

Column 5, lines 35-42 of Boesch: *"In the preferred embodiment, CIS 140 comprises ... consumer data structure 146 which stores consumer information which can be used in future transactions, merchant data structure 148 which stores information pertaining to different merchants, consumer transaction log 150 which stores information pertaining to the transactions for registered consumers, and merchant transaction log 152 which stores*

information pertaining to transactions for registered and non-registered consumers.” Nothing in this passage suggests that the CIS responds to the message from the browser by performing steps (a)-(c) of the claim. It is not clear how the Examiner is relying on this passage.

Column 6, lines 35-45 of Boesch: *“Consumer data structure 146 stores label-value pairs relating to consumers, including consumer 100, that have completed the registration process with the operator of CIS 140. The label-value pairs in consumer data structure 146 represent information that is necessary, and may include information that is useful to complete a transaction. The purchasing information can include the customer's name, billing address, shipping address, and credit card number, however this information should not be construed as a limitation. The useful information can also include email, telephone numbers, facsimile numbers, and user preference data (regarding shipping address, shipping method, and related data), however this information should not be construed as a limitation.”* While this passage may indicate that the CIS stores the names of registered users/consumers, nothing in this or any other portion of Boesch suggests that a user’s name is incorporated into an instance of an object that is returned to the user computer for display in the web page. To the contrary, the user’s name and other purchasing information is apparently stored by the CIS so that it can be communicated directly to a merchant when the user completes a purchase with the merchant. See Boesch at, e.g., column 3, lines 55-61.

Column 7, lines 18-27 of Boesch: *“The CIS software receives and processes the message to determine if the consumer's browser contains an identifier which identifies a consumer that matches a data entry in a file in the consumer data structure of the CIS 206. The CIS software determines whether a single user or multiple users have used the consumer's browser 208 by checking the consumer data structure. If the CIS software identifies more than one user, the CIS software will select a user based on a selection criteria generated by the operator of the CIS.”* This passage refers to the process by which the CIS uses a browser identifier, such as a cookie, to determine whether any consumer information is stored in association with the particular browser. As with the other cited portions of Boesch, nothing in this passage suggests that the CIS performs the particular combination of steps, (a)-(c), recited in the claim.

In view of the foregoing, Boesch does not teach or suggest at least the bolded limitations of claim 67, and particularly the combination of steps (a)-(c).

Linehan does not overcome this deficiency in Boesch, and the Third Examiner's Answer does not contend otherwise. In addition, the Third Examiner's Answer does not identify any particular reason that would have prompted one of ordinary skill and creativity to modify Boesch and/or Linehan to arrive at the invention of claim 67.

In view of the foregoing, the Examiner has not established a prima facie case of obviousness with respect to claim 67. The rejections of claims 67-69 are therefore improper.

3. Rejection of claims 46-52 and 60-64 over Katis

Claims 46-52 and 60-64, of which claims 46 and 60 are independent, stand rejected on obviousness grounds over Katis.

Independent claim 46

In the Second Appeal Brief, Appellant argued that the rejection of claim 46 is improper because Katis does not teach or suggest the following steps in the context of the other limitations of the claim:

providing, in a web page of the merchant web site and in conjunction with a description of a purchasable item, a reference to a graphic served by the information service server, such that when a browser running on the computer of the user retrieves the web page, the browser is caused to request the graphic from, and transmit the cookie to, the information service server; and

at the information service server, in response to receiving the cookie and a request for the graphic from the computer of the user, returning to the computer of the user a single-action purchase graphic indicating that the item may be purchased with a single selection action, said single-action purchase graphic being selectable by the user to purchase the item.

In response, the Third Examiner's Answer points to two passages of Katis (U.S. Patent No. 6,601,761). Third Examiner's Answer at pages 12 and 13, under heading Fifth Issue. Each passage is reproduced and discussed below.

Column 3, line 58 to column 4, line 4 of Katis: *"In order to make a payment using the co-branded electronic payment platform for an embodiment of the present invention, the user invokes the co-branded electronic wallet application, and a co-branded electronic wallet window*

is displayed for the user by the wallet server. The user enters a selection to make the payment with the user's payment information stored by the wallet server, and the wallet server automatically sends the user's payment information to a merchant's website server for the user. The payment information sent by the wallet serve includes, for example, the user's stored credit card, debit card, checking, or savings account related information or the stored digital payment tokens pre-allocated for the user from the user's credit card, debit card, checking, or savings account."

This passage fails to suggest or render obvious many of the claim features at issue. For example, nothing in this passage, or any other portion of Katis, suggests "providing, in a web page of the merchant web site and in conjunction with a description of a purchasable item, a reference to a graphic served by the information service server." In this regard, nowhere does Katis say that the wallet display is a graphic. Katis' statements that "a co-branded electronic wallet window is displayed" and "the user makes a selection," suggest that it is not.

As another example, this passage of Katis does not teach or suggest the following: "when a browser running on the computer of the user retrieves the web page, the browser is caused to request the graphic." This is true even if, *arguendo*, the wallet display in the wallet window is treated as the "graphic" recited in the claim. In this regard, when a browser in Katis loads a merchant web page from which the wallet can be invoked, the page does not cause the browser to retrieve the wallet display. Rather, the wallet display is apparently retrieved and displayed only if the user "invokes the co-branded electronic wallet application."

In addition, nothing in this or any other portion of Katis suggests that the user's browser transmits a cookie to the wallet server when the user invokes the wallet application on the merchant site. Indeed, this apparently would not be necessary in Katis since the user's request to invoke the wallet application apparently passes through the merchant's server. See Katis at column 6, lines 11-15. Thus, the following limitations of claim 46 are not met in the context of the claim: "the browser is caused to request the graphic from, and transmit the cookie to, the information service server."

Column 9, lines 25-35 of Katis: *"...when the consumer 2 invokes the co-branded electronic wallet, and the browser on the consumer's PC 4 opens up the window 14 and serves up the wallet outside the frame in which the consumer 2 is shopping, the consumer 2 is able to*

pay the merchant for the goods or services with the consumer's tokens stored in the electronic cash purse server 24 the co-branded electronic wallet. Instead of checking to confirm, for example, whether or not there is sufficient credit on the consumer's credit card account at the time of the transaction, it is done prior to the time of the transaction, and only the authenticity of the tokens is checked at the time of the purchase."

This passage does not address or overcome any of the deficiencies noted above. The Third Examiner's Answer apparently relies on this passage in connection with the following portion of claim 46: "a single-action purchase graphic indicating that the item may be purchased with a single selection action, said single-action purchase graphic being selectable by the user to purchase the item." The passage does not, however, suggest such a single-action purchase graphic. In this regard, Katis is silent on the exact sequence of steps performed by the user to complete the purchase transaction using tokens. For example, there is no indication of whether the user has to confirm the transaction after requesting payment using tokens.

In view of the foregoing, Katis does not teach or suggest all of the limitations of claim 46. In addition, the Third Examiner's Answer does not identify a reason that would have prompted one of ordinary skill in the art to modify Katis to arrive at the invention of claim 46.

For at least these reasons, the Examiner has not established a prima facie case of obviousness with respect to claim 46. The obviousness rejections of claims 46-52 are therefore improper.

Independent claim 60

Appellant argued in the Second Appeal Brief that Katis does not teach or suggest the following features of claim 60 in the context of the other recitations of the claim:

providing, within coding of the web page, a reference to a graphic served by the server, such that when a browser retrieves the web page, the browser is caused to request the graphic from the server; and

when a browser running on the computer of the user retrieves the web page from the web site and sends a resulting request for the graphic to the server, responding to the request by at least: (a) using the cookie transmitted with the request to identify the name of the user, (b) incorporating the name of the user into an image, and (c) returning the image to the user computer for display within the web page.

The Third Examiner's Answer does not fully address the foregoing limitations, and especially those of the second subparagraph quoted above ("when a browser running...web page"). Indeed, as with the two previous Examiner's Answers, claim 60 is not discussed in the Third Examiner's Answer.

With respect to the first subparagraph quoted above ("providing...from the server"), as explained above in connection with claim 46, Katis does not use such a reference or process to display the wallet. In this regard, when the user loads the relevant web page of the merchant web site, the browser is not caused to request the wallet display. Rather, the user apparently must invoke the wallet application. In addition, nothing in Katis suggests that the wallet display is a graphic.

With respect to the second subparagraph, nothing in the Katis suggests "incorporating the name of the user into an image," particularly in the context of the overall process in claim 60. The portions of Katis (column 6, lines 37-40 and column 8, lines 46-56) cited by the Third Examiner's Answer in connection with dependent claim 47 do not disclose or suggest this feature. In addition, even if, *arguendo*, Katis' wallet display is treated as the "image" recited in claim 60, the limitation "returning the image to the user computer for display within the web page" still is not met. In this regard, as discussed above, the wallet is not displayed within the merchant's web page in Katis, but is displayed in a separate window.

In view of the foregoing, the Examiner has not established a *prima facie* case of obviousness with respect to claim 60. The rejections of claims 60-64 are therefore improper.

4. Rejection of claims 41, 42, 44 and 45 under 35 U.S.C. § 101

The Third Examiner's Answer rejects claims 41, 42, 44 and 45 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Third Examiner's Answer at pages 5 and 6. Claims 41 and 44 are independent. As explained below, the rejection is improper at least because each of these claims is "tied to a particular machine or apparatus" under *In re Bilski*, 2007-1130, slip op. (Fed. Cir. Oct. 30, 2008).

Claims 41 and 42

Claim 41 is independent, and claim 42 depends from Claim 41. Claim 41 reads as follows, with emphasis added for purposes of discussion:

41. A method for facilitating online transactions between users and online merchants, the method comprising:

storing customer information for each of a plurality of registered users in a database, said customer information including payment information of registered users;

receiving a request that the customer information of a registered user be provided **to a selected merchant web site system**, said request generated in response to an action performed by the registered user **while accessing the merchant web site system**;

receiving authentication information submitted by the registered user;

verifying that the authentication information submitted by the registered user is valid; and

in response to determining that the authentication information submitted by the registered user is valid, **transmitting customer information of the registered user to the selected merchant web site system to allow the registered user to make a purchase from the merchant web site system** using previously specified information stored in the database;

whereby the registered user may make a purchase **from the selected merchant web site system** without having a preexisting account with the selected merchant web site system;

wherein the customer information of the registered user transmitted **to the merchant web site system** further includes an interests profile that reflects purchases made by the registered user from each of a plurality of online merchants, such that **the merchant web site system** may personalize web site content for the registered user.

The rejection of claim 41 is improper because, among other reasons, each of the recitations highlighted above ties the claimed method to a particular machine or apparatus, namely a “merchant web site system.” See *Bilski* at page 10 (stating that “A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus....”). In connection with this issue, the phrase “merchant web site system,” as recited in multiple locations in

the claim, refers to a system that implements a merchant web site. As is well known in the art, such a system necessarily includes at least one physical server that serves the web site's content. *See, e.g.*, present application at Figure 1 (which depicts a server 108 that implements a merchant web site 106), and page 6, lines 23 and 24 (stating that the merchant web site 106 "is implemented using one or more physical servers 108"). Thus, the recitations of "merchant web site system" tie the claimed method to a particular machine or apparatus—namely a system that implements a merchant web site via one or more physical servers.

The Third Examiner's Answer appears to acknowledge that a "merchant web site system" is a "particular machine," but contends that the "tie" to the particular machine is insufficient. Specifically, the Third Examiner's Answer states that the claim fails prong (1) of *Bilski* "because the 'tie' (e.g., transmitting data to a web site system) is representative of extra-solution activity." Third Examiner's Answer at page 6. This assertion is presumably based on the statement at page 24 of *Bilski* that the "the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity." In the present case, however, the recited involvement of the merchant web site system is neither "insignificant" nor "extra-solution." In this regard, the recited transmission of customer information to the merchant web site system is a significant and central part of the claimed method because, e.g., it allows the registered user "to make a purchase from the merchant web site system using previously specified information," and allows "the merchant web site system [to] personalize web site content for the registered user." Thus, the "tie" to the particular machine is sufficient.

The rejection of claim 41 is also improper for the independent reason that the recitations "storing customer information ... in a database" and "transmitting customer information" inherently require the use of, and thus tie the method to, a particular machine.

For at least these reasons, the rejections of claims 41 and 42 under 35 U.S.C. § 101 are improper.

Claims 44 and 45

Claim 44 is independent, and claim 45 depends from Claim 44. Claim 44 reads as follows, with emphasis added for purposes of discussion:

44. A method of supporting transactions between users and online merchants, the method comprising:

providing an electronic wallet service that allows users to make purchases from online merchants using previously-specified payment information;

maintaining a purchase history for at least a first user of the wallet service, said purchase history representing purchases made by the first user from a plurality of online merchants;

generating an interests profile that reflects said purchases made by the first user from the plurality of online merchants; and

transmitting the interests profile of the first user to a web site system of at least one online merchant to allow the online merchant to provide personalized web site content to the first user.

The rejection of claim 44 is improper because, among other reasons, the claim language emphasized above ties the claimed method to a particular machine or apparatus, namely a “web site system.” In connection with this issue, the phrase “web site system” refers to a system that implements a web site. As is well known in the art, such a system necessarily includes at least one physical server. See, e.g., present application at Figure 1 (which depicts a server 108 that implements a merchant web site 106), and page 6, lines 23 and 24 (stating that the merchant web site 106 “is implemented using one or more physical servers 108”). Thus, the emphasized language ties the method of claim 44 to a particular machine or apparatus—namely a system that implements a web site via one or more physical servers.

The Third Examiner’s Answer appears to acknowledge that a “web site system” is a “particular machine,” but contends that the “tie” to the particular machine is insufficient. Specifically, the Third Examiner’s Answer states that the claim fails prong (1) of *Bilski* “because the ‘tie’ (e.g., transmitting data to a web site system) is representative of extra-solution activity.” In the present case, however, the recited involvement of the web site system is neither “insignificant” nor “extra-solution.” In this regard, the recited transmission of the “interests profile of the first user” to the “web site system of at least one online merchant” is significant because, e.g., it allows “the online merchant to provide personalized web site content to the first user.” Thus, the “tie” to the particular machine is sufficient.

Appl. No. : **09/457,839**
Filed : **December 9, 1999**

The rejection of claim 44 is also improper for the independent reason that the recitation of an “electronic wallet service that allows users to make purchases from online merchants” inherently requires, and thus ties the claimed method to, a particular machine.

For at least these reasons, the rejections of claims 44 and 45 under 35 U.S.C. § 101 are improper.

CONCLUSION

For the reasons set forth above, Appellant respectfully submits that the rejections of claims 36-39, 41, 42, 44-52, 60-64 and 66-69 are improper, and requests that these rejections be reversed.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: December 30, 2008

By: /Ronald J. Schoenbaum/
Ronald J. Schoenbaum
Reg. No. 38,297
Customer No. 20,995
949-721-2950